

REMARKS/ARGUMENTS

Claims 22-24, 26-35, 37-44 and 47-51 are pending in this application. Claims 25 and 36 have been cancelled without prejudice.

The Office Action rejects claims 22-24, 29, 34, 35, and 40 under 35 U.S.C. §102(e) as being anticipated by Gueret (U.S. Patent No. 6,073,634). The Office Action concedes that Gueret fails to disclose bristles made from polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, or polymer based on starch or starch derivatives. Claims 22-24, 29, 34, 35, and 40 each include the feature of the one or more bristles consisting essentially of a biodegradable, naturally based polymeric material being selected from the group consisting of: polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof. Applicants respectfully request that this rejection be withdrawn.

The Office Action rejects claims 22-24, 29, 31, 32, 34, 35, 40, 42 and 43 under 35 U.S.C. §102(e) as being anticipated by Castells Ribas (U.S. Patent No. 6,314,967). The Office Action concedes that Castells Ribas fails to disclose bristles made from polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, or polymer based on starch or starch derivatives. Claims 22-24, 29, 31, 32, 34, 35, 40, 42 and 43 each include the feature of the one or more bristles consisting essentially of a biodegradable, naturally based polymeric material being selected from the group consisting of: polylactide, polycaprolactone,

polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof. Applicants respectfully request that this rejection be withdrawn.

The Office Action rejects claims 22, 24, 30, 34 and 41 under 35 U.S.C. §102(b) as being anticipated by Morganroth (U.S. Patent No. 4,209,027). The Office Action concedes that Morganroth fails to disclose bristles made from polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, or polymer based on starch or starch derivatives. Claims 22, 24, 30, 34 and 41 each include the feature of the one or more bristles consisting essentially of a biodegradable, naturally based polymeric material being selected from the group consisting of: polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof. Applicants respectfully request that this rejection be withdrawn.

The Office Action rejects claims 25-28, 36-39 and 47-51 under 35 U.S.C. §103(a) as being unpatentable over Gueret. The Office Action asserts that it would have been obvious to modify the Gueret applicator bristles by making them from a polymeric material selected from the group consisting of: polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof based upon selecting a known material on the basis of its suitability for the intended use. This rejection is moot as to claims 25 and 36, which have been cancelled. This reference will be addressed with respect to

claims 22 and 34, which incorporate the features of claims 25 and 36, respectively.

Gueret describes bristles that can be made from vegetable or natural fiber:

Thus, the bristles 6 of the applicator 1 may be natural or synthetic. They may be made of vegetable, animal or natural fibers, be made of metal such as steel, glass or wood, or of elastically deformable materials such as elastomers, vulcanized elastomers or thermoplastic materials. (col. 8, lines 41-46).

The Office Action, relying upon In re Leshin, 125 USPQ 416 (CCPA 1960), asserts that applicator bristles made of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof, are an obvious design choice because it is a selection of a known material on the basis of its suitability for the intended use. Applicants respectfully submit that the Office Action's reliance on In re Leshin is misplaced, and modifying the Gueret bristles to be made from one or more of the specific polymeric materials recited in claims 22 or 34 is a hindsight extrapolation of the prior art.

In re Leshin, and the caselaw consistent with the Leshin decision, (see also Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327 (1945)), requires that there is knowledge of the suitability of the known material for the intended purpose. The Leshin Court concluded that it would have been obvious to select a known plastic "to make [the patentee's] container-dispenser of a type made of plastics prior to the invention, the selection of the plastics being on the basis of suitability for

the intended use." In re Leshin at 417-418. The prior art that was being cited against the patentee showed "a similar container of molded plastic." In re Leshin at 417. Similarly, the Sinclair Court determined that in making a rapidly drying printing ink, it would have been obvious to utilize a solvent that would evaporate quickly upon heating. Since a boiling point is indicative of a rate of evaporation, the patentee in Sinclair made selections from a list of solvents and their boiling points. The Sinclair Court found that the patentee was doing no more than "selecting the last piece to put into the last opening in a jig-saw puzzle." Sinclair at 335. Indeed, the choice of solvent was being dictated to the patentee by these known, required properties, and the solvent had no functional relation to the printing ink involved (it was merely an inert carrier). See U.S. v. Adams 383 U.S. 39 (1966) distinguishing In re Leshin.

In contrast, Applicants use of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof, for applying a material or cosmetic composition to a human, is not a mere selection based upon knowledge of the suitability of these materials for the intended purpose of applying a material or cosmetic composition to a human. This is not merely a design choice because this was an unknown material for use in cosmetic brushes for the application of cosmetics. The suitability of these materials for use in applying the cosmetic composition was unknown prior to Applicants' discovery.

The patentability of claims 22 and 34 is supported by the United States Supreme Court's decision in U.S. v. Adams 383 U.S.

39 (1966). The Adams device was a non-rechargeable electrical battery having a first electrode made from magnesium and a second electrode made from cuprous chloride, with a battery fluid of plain or salt water. In an argument similar to the one put forth in the present Office Action, the U.S. Government contested the validity of the Adams patent by arguing that "wet batteries comprising a zinc anode and silver chloride cathode are old in the art; and that the prior art shows that magnesium may be substituted for zinc and cuprous chloride for silver chloride." Adams at 48. The U.S. Government submitted that the "combination of magnesium and cuprous chloride in the Adams battery was not patentable because it represented either no change or an insignificant change as compared to prior battery designs." Id. The U.S. Supreme Court rejected this argument, stating that "[d]espite the fact that each of the elements of the Adams battery was well known in the prior art, to combine them as did Adams required that a person reasonably skilled in the prior art must ignore that (1) batteries which continued to operate on an open circuit and which heated in normal use were not practical; and (2) water-activated batteries were successful only when combined with electrolytes detrimental to the use of magnesium." Adams at 51-52.

Similarly, Applicants have utilized polymeric materials whose use was unknown in cosmetic brushes for the application of cosmetics. The Gueret patent relied upon by the Office Action describes the use of vegetable fibers or natural fibers in general without any suggestion of the particular materials set forth in claims 22 and 34. Applicants have discovered that the bristles made of these materials have attributes of increased slip, increased wicking, the ability to make thin fibers, silky feel, excellent UV stability, oil and grease resistance, and

good durability including superior twist retention, resilience, and elastic recovery. All of these attributes are important properties for bristles used in the manufacture of brushes for the application of a cosmetic composition. Applicants have discovered that these polymeric materials are suitable for manufacture into the myriad of brush shapes as depicted, for example, in Figs. 1 through 7.

Claims 26-28 and 47-48 depend from claim 22, and claims 37-39 and 49-51 depend from claim 34. Thus, these claims are also not obvious over Gueret.

The Office Action rejects claims 25-28, 33, 36-39, 44 and 47-51 under 35 U.S.C. §103(a) as being unpatentable over Castells Ribas. The Office Action asserts that it would have been obvious to modify the Castells Ribas applicator bristles by making them from a polymeric material selected from the group consisting of: polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof based upon selecting a known material on the basis of its suitability for the intended use. This rejection is moot as to claims 25 and 36, which have been cancelled. This reference will be addressed with respect to claims 22 and 34, which incorporate the features of claims 25 and 36, respectively.

Castells Ribas describes bristles that can be made from vegetable fiber, which is preferably cotton, linen or the like. (col. 2, lines 13-15). As described above, Applicants have utilized particular polymeric materials recited in claims 22 and 34, whose use was unknown in cosmetic brushes for the application of cosmetics. Castells Ribas describes the use of

cotton or linen fibers without any suggestion of the particular materials set forth in claims 22 and 34. The suitability of these materials for use in applying the cosmetic composition was unknown prior to Applicants' discovery.

Claims 26-28, 33 and 47-48 depend from claim 22, and claims 37-39, 44 and 49-51 depend from claim 34. Thus, these claims are also not obvious over Castells Ribas.

The Office Action rejects claims 25-28, 36-39, 47, 49 and 50 under 35 U.S.C. §103(a) as being unpatentable over Morganroth. The Office Action asserts that it would have been obvious to modify the Morganroth applicator bristles by making them from a polymeric material selected from the group consisting of: polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof based upon selecting a known material on the basis of its suitability for the intended use. This rejection is moot as to claims 25 and 36, which have been cancelled. This reference will be addressed with respect to claims 22 and 34, which incorporate the features of claims 25 and 36, respectively.

Morganroth describes bristles that can be made from vegetable fibers and animal hair:

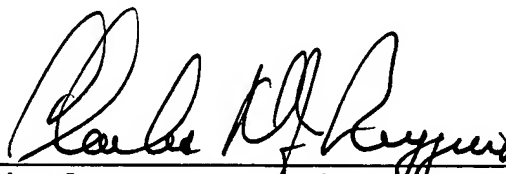
The bristles of a brush type spreading means may be natural bristle such as pig hair, horse hair, and the like, vegetable fibers or synthetic fibers of the type currently used for making brushes used in conjunction with hair treating liquids. Among synthetic fibers that may be used are olefin fibers such as oriented polypropylene, oriented nylon, and the like. (col. 40, lines 57-63).

As described above, Applicants have utilized particular polymeric materials recited in claims 22 and 34, whose use was unknown in cosmetic brushes for the application of cosmetics. Morganroth describes the use of vegetable fibers and animal hair without any suggestion of the particular materials set forth in claims 22 and 34. The suitability of these materials for use in applying the cosmetic composition was unknown prior to Applicants' discovery.

Claims 26-28 and 47 depend from claim 22, and claims 37-39, 49 and 50 depend from claim 34. Thus, these claims are also not obvious over Morganroth.

In view of the foregoing, applicants respectfully submit that all claims present in this application patentably distinguish over the cited prior art. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejections of the claims. Also, applicants respectfully request that this application be passed to allowance.

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